

104



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,229	01/29/2001	Robin Young Smith	9258-2	9684

7590 11/03/2004
Mitchell S. Bigel
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, NC 27627

EXAMINER

TO, BAOQUOC N

ART UNIT PAPER NUMBER

2162

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,229

Applicant(s)

SMITH ET AL.

Examiner

Baoquoc N To

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/25/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 18-20, 24-34, 41-54 and 61-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-20, 24-34, 41-54 and 61-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/09/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11, 18-20, 24-34, 41-54 and 61-63 are pending in this application.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 09/09/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 24, 44, 18, 41, and 61 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5-11, 24, 26, 28-34 and 44, 46 and 47-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Budenstein et al. (Organic Syntheses online: the

values of XML, Metadata, and Community interaction in electronic journals, October 22-25, 2000).

Regarding on claims 1, 24 and 44, Budenstein teaches a computerized method of determining parameters for chemical synthesis comprising:

Accepting a user identification of a target chemical (the chemical is searchable by entering the name) (page 26, lines 18-20 and fig. 1, page 27); and

Displaying a listing of reagent chemicals that are used to synthesis the target chemical, a listing of equipment that is used to synthesis the target chemical and a listing of a procedure that is used to synthesis the target chemical by reacting the reagent chemicals in the equipment according to the procedure, in response to the user identification of the target chemical (fig. 1, shows the target chemical "Nitrophenyl" along with the chemical formula, the reagents, the procedure and the equipment to synthesis the target chemical) (page 27, entire page).

Regarding on claims 3, 26 and 46, Budenstein teaches the accepting a user identification of a target chemical is preceded by:

Entering into a database, a plurality of target chemicals, a plurality of corresponding listings of reagent chemicals that are used to synthesize the plurality of target chemicals, a plurality of corresponding listing of equipment that is used to synthesize the plurality of the target chemicals and a plurality of corresponding listing of procedures that are used to synthesize the plurality of target chemicals by reacting the corresponding reagent chemicals in the corresponding equipment according to the

corresponding procedure (the target chemical is stored along with reagents, procedure, and equipment) (page 26, lines 15-22).

Regarding on claims 5, 28 and 48, Budenstein teaches accepting a user identification of a target chemical comprises accepting a user identification of a target chemical by chemical formula, chemical structure, chemical compound name and/ or CAS number (chemical name) (page 27, fig. 1).

Regarding on claims 6, 29 and 49, Budenstein teaches accepting a user identification of a target chemical comprises:

Displaying a listing of target chemical that match the user query (page 27, fig. 1);
and

Accepting a user selection of a target chemical from the listing of target chemicals that match the user query (page 27, fig. 1).

Regarding on claims 7, 30 and 50, Budenstein teaches accepting user identification of a target chemical comprises:

Accepting a user identification of a reaction type (page 27, fig. 1);

Displaying a listing of target chemicals that are synthesized using the reaction type (page 27, fig. 1); and

Accepting a user selection of a target chemicals from the listing of target chemicals that are synthesized using the reaction type (page 27, fig. 1).

Regarding on claims 8, 31 and 51, Budenstein teaches the following is performed between the accepting and the displaying:

Displaying a listing of procedures that can be used to synthesize the target chemical (page 27, fig. 1); and

Accepting a user selection of a procedure from the listing of procedures that can be used to synthesis the target chemical (page 27, fig. 1).

Regarding on claims 9, 32 and 52, Budenstein teaches the following is performed between the accepting and the displaying:

Accepting a user selection of a desired quantity of the target chemical (page 27, fig. 1); and scaling the listing of the reagent chemicals so as to synthesized the desired quantity of the target chemicals (page 27, fig. 1); and

Displaying a scale listing of the reagent chemicals that are used to synthesize the desired quantity of the target chemical, a listing of equipment that is used to synthesize the desired the desired quantity of the target chemical (page 27, fig. 1).

Regarding on claims 10, 38 and 63, Budenstein teaches accepting a user identification of a target chemical comprises:

Displaying a prioritized listing of target chemicals that match the user query (page 27, fig. 1);

Accepting a user selection of a target chemical from the prioritized listing of target chemicals that match the user query (page 27, fig. 1).

Regarding on claims 11, 39 and 64, Budenstein teaches accepting a user identification of a target chemical comprises:

Accepting user identification of a chemical (page 27, fig. 1);

Displaying a listing of procedures that use the chemical as a reagent chemical (page 27, fig. 1); and

Accepting a user selection of a procedure from the listing of procedures that use the chemical as a reagent chemical (page 27, fig. 1).

5. Claims 2, 4, 25, 27, 45, 47, 18-20, 41-43 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruger Chemical (Copy right 12/04/2000) in view of).

Regarding on claims 18, 41 and 61, Ruger Chemical teaches a computerized method of obtaining materials for chemical synthesis comprising:

Electronically ordering (purchasing@rugerchemical.com) (page 3, line 27) a target chemical, reagent chemicals that are used to synthesize the target chemical (chemical list) (page 3, lines 19-16) and/or equipment that is used to synthesis the target chemical, from an electronically displayed listing of the reagent chemicals that are used to synthesize the target chemical, of the equipment that is used to synthesize the target chemical and of procedure that is used to synthesize the target chemical by reacting by response to user input to order the target chemical, the reagent chemicals that are used to synthesize the target chemical and/or the equipment that is used to synthesis the target chemical. Ruger chemical does not explicitly teach synthesis the target chemical using the procedures and equipment. On the other hand, Rubenstein teaches, "fig.1, illustrates target chemical "Nitropheny" and the reagents, the procedures and the equipment to synthesis the Nitropheny" (page 27, fig. 1). The concept of retrieving the target chemical by using the procedure, equipments and reagents is

taught by Rubenstein. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Ruger's system to include the concept of synthesis the target chemical by using the reagents, procedure and equipments as taught by Rubentein in order to produce a system to aid the people to synthesis chemical and at the same time to order required content for the synthesizing process.

Regarding on claims 19, 42 and 62, Ruger chemical teaches the electronically ordering comprises:

Electronically ordering a kit of the reagent chemicals that are used to synthesize the target chemical (page 2).

Regarding on claims 20, 43 and 63, Ruger chemical teaches the electronically ordering comprises:

Electronically ordering a kit of the equipment that is used to synthesize the target chemical (page 2).

Claims 2, 4, 25, 27, 45 and 47 are rejected under the same reason as claim 18, in addition, Ruger chemical also allow the user to input the chemical from the menu list or user can input into the electronic ordering (page 2).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Art Unit: 2162

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

The fax numbers for the organization where this application or proceeding is assigned are as follow:

(703) 872-9306 [Official Communication]

Hand-delivered responses should be brought to:

Crystal Park II


2121 Crystal Drive

Arlington, VA 22202

Fourth Floor (Receptionist).

Baoquoc N. To

October 27, 2004


JEAN M. CORRIELUS
PRIMARY EXAMINER